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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,127	01/13/2004	Anthony R. Hagale	AUS920031037US1	3141

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EXAMINER	
VY, HUNG T	
ART UNIT	**PAPER NUMBER**
2163	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/756,127	HAGALE ET AL.	
	Examiner	Art Unit	
	Hung T. Vy	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 0200*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. As of entry of the amendment filed on 11/27/2007, claims 1-20 are pending in this application. Upon reconsideration, the Applicant's arguments are not persuasive (see response Applicant's argument).

Summary of claims

2. Claims 1-20 are pending.

Claims 1-20 are rejected.

Claim Rejections - 35 USC 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete".

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility <http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the "practical application, result, concrete, useful and tangible" limitations are not claimed in Applicant's claims and the claims do not recited any purpose of claimed invention, Examiner believes that the above listed claims are nonstatutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-10, 13-16, and 19-20 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Reisman (U.S. Patent No. 6,954,755).

With respect to claims 1, 8, and 14, Reisman discloses a method, an article comprising one or more machine-readable storage media containing instructions that when executed enable a processor and apparatus, to: a storage unit having stored therein a database (102)(see fig. 1A); and control unit (4) communicatively coupled to the storage unit, the control unit adapted to: receiving a search term (Query (a, 1), (a, 2), etc.) from a user (s10); providing a search result (s40, s60) to the user based on comparing at least a portion of the received search term (i.e., "*Query*")(s10) with at least a portion of one or more entries stored in a database (10)(see column 9, line 12-15 and fig. 2), providing a copy of a feedback module (s80) for execution on a processor base device of the user (processor base device at the user 5) to monitor at least one online action of the user (see column 19, line 25-28) in response to providing the search result (s60) (see column 6, line 27-35) (see fig. 2), and receiving (s100), from the feedback module (s80), information associated with the at least one monitored user action (see column 19, line 25-28) to adjust at least one entry stored in the database (10)(See column 7, line 14-17) (see fig. 2).

With respect to claims 2, 9, and 15, Reisman discloses the act of receiving comprises receiving the information from a processor-based device (4) associated with the user (user 1, user 2, etc.), and wherein the act of providing comprises providing a feedback module to the processor-based device (4) of the user, collecting, using the feedback module, information associated with the at least one monitored user action, (see column 19, line 2-28) and providing, using the feedback module, the collected information over a network (See fig. 1,2).

With respect to claims 3, 10, and 16, Reisman discloses providing the collected at least one of at selected time intervals and in selected data amounts (see column 9, line 16).

With respect to claims 6, 13 and 19, Reisman discloses at least one of adjusting a meta tag associated with at least one entry stored in the database, removing the at least one entry stored in the database, and adjusting data associated with the at least one entry stored in the database (see column 15, line 15-25).

With respect to claims 7, and 20, it is inherent that Reisman discloses adjusting the at least one entry stored in the database to improve the relevancy of that entry because Reisman discloses this method has a lot improvement over prior art (see column 18, line 63-65).

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth insection 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 11 and 17 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Reisman (U.S. Patent No. 6,954,755) in view of Marcjan et al. (U.S. Pub No. 2004/0254938).

With respect to claims 4, 11, and 17, Reisman discloses all limitations of claimed invention recited in claim 1 except for claim the feedback module comprises providing a copy of the feedback module in response to determining that the processor based device does not have a copy of the feedback module. However, Marcjan et al. discloses a copy of the feedback module in response to determining that the processor-based device does not have a copy of the feedback module (Marcjan: i.e., "*whether the computer needs additional information*")(see paragraph 0049). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Reisman's system to have a copy of the feedback module in response to determining that the processor-based device does not have a copy of the feedback module in order to help the user to select the correct query since such arranging a backup data in response to determining that the processor based device does not have a copy of the feedback module for stated purpose has been well know in the art as evidenced by teaching of Marcjan et al (see paragraph 0056).

6. Claims 5, 12 and 18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Reisman (U.S. Patent No. 6,954,755) in view of Reisman's background of the invention.

With respect to claims 5, 12 and 18, Reisman discloses the method that wherein providing the result comprises, a position of resulted selected by the user relative to the plurality of results provided, how long the user stay on a webpage associated with the one or more of the plurality of results a user visits in response to being provided the results (see column 12, line 27-35) but Reisman does not disclose the feedback module

to monitor at least one of how quickly the user selects a selected result from the plurality of results. However, in the background of Reisman's invention discloses a key performance metric, recall, is the completeness of the set of results returned (see columned 3, line 17-20). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Resisman's system to monitor the how quickly the user selects a selected result from the plurality of results so the instruction that when executed enable a processor has improvement search results in such systems (see column 3, line 41).

Response to Arguments

7. Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive. The Applicant's arguments are following:

- A) "As described in the patent application, one or more embodiments of the present invention are directed to a method and apparatus for collecting user feedback from search queries, and this feedback can then be used to update a database to improve future search inquiries. See, e.g., Patent Application, p. 9, lines 13-18. Indeed, the practical application and the resulting tangible result(s) described in the exemplary embodiments of the patent application are reflected in the pending claims. Consider claim 1, for example. Claim 1, in part, calls for receiving information associated with a monitored user action to adjust an entry of a database. By virtue of updating a database with useful user feedback, a tangible result (e.g., an updated database) is thereby achieved. The practical application of having

an updated database is that subsequent search inquiries will yield improved and more helpful results. See, e.g., Patent Application, p. 9, lines 13-15 (stating that "more meaningful (or relevant) results are returned for each query" from an updated database). Thus, claim 1 has a practical application and also provides tangible results. The other pending claims similarly have practical applications and produce tangible results. Consequently, all of the pending claims are directed to statutory subject matter. The Examiner is therefore respectfully requested to withdraw the 35 USC § 101 rejections.", page 10, second paragraph.

- B) "Claim 1 is representative, and is discussed first. Among other things, claim 1 calls for providing a copy of a feedback module for execution on a processor-based device of the user to monitor at least one online action of the user. Reisman does not teach at least this feature. In particular, Reisman does not teach providing a copy of a feedback module, such as a software utility, to the user's device for execution to monitor one or more of the user's online actions. Indeed, the Examiner admits that Reisman includes no such teaching. See Office Action, p. 6 (stating that the Reisman does not disclose providing a copy of the feedback module).

In response to the Applicant's argument A above, the Applicant's argument are not persuasive because claims 1-20 are directed a method. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed

subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for *updating a database*. The claimed limitation *for adjusting at least one entry stored in the database* in the step of *receiving* is an intended used limitation as *receiving.* This produced result remains in the abstract, e.g., *updating a database or adjusting one entry stored in the database,* this database has not been updated yet, and, thus, fails to achieve the required status of having real world value.

In response to the Applicant's argument B above, the Applicant's argument are not persuasive because Reisman clearly discloses providing a copy of a feedback module (s80) for execution on a processor base device of the user (processor base device at the user 5) to monitor at least one online action of the user (see column 19, line 25-28) in response to providing the search result (s60) (see column 6, line 27-35) (see fig. 2). The Examiner admits that Reisman does not teaching the limitation in claim 4 as providing the feedback module comprises providing a copy of the feedback module in response to determining that the processor-based device does not have a copy of the feedback module. Thus, Reisman discloses the claimed feature of providing a copy of a feedback module for execution on a processor-based device of the user to monitor at least one online action of the user.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy
Art Unit 2163
January 19, 2007.

DON WONG
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